



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,157	03/14/2001	Hajime Matsubara	26.1699	1765

21171 7590 04/20/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,157

Applicant(s)

MATSUBARA, HAJIME

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 3622

DETAILED ACTION

1. Claims 1-17 have been examined.

Claim Rejections - 35 USC § 112

2. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Please see claim 3, 7, 11.

Claim 14, 15 recites the limitation "through that transmission area". There is insufficient antecedent basis for this limitation in the claim. No transmission area has been stated in the claim up to that point. Claim 14, 15 should read, "through a transmission area". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 7, 9-12, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka (6,366,298) in view of Cohen (5,966,696).

Claim 1, 12: Haitsuka discloses a method, medium transmitting advertising information, comprising:

receiving position information from a client (col 5, line 59-col 6, line 4; col 6, lines 42-45);
determining a passage count of the client in a predetermined advertising information transmission area in which the position information belongs and storing the passage count; and
transmitting to the client advertising information according to the passage count of the client in the transmission area (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user

Art Unit: 3622

frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Claim 2: Haitsuka and Cohen disclose the method according to claim 1. Haitsuka further discloses that the advertising information according to the passage count of the client in the transmission area is transmitted to the client in response to reception from the client of a request to transmit advertising information (col 4, lines 52-56).

Claim 3: Haitsuka and Cohen disclose the method according to claim 1.

Haitsuka does not explicitly disclose that the advertising information is transmitted in the passage count of the client has reached a predetermined value.

However, Haitsuka discloses monitoring user activities including geographic activity, that the advertiser can utilize a wide range of criteria for sending advertising (Fig. 3; col 6, lines 13-28), and that the frequency of advertisements can be set (col 6, lines 13-28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Haitsuka can make user visits to a certain area a criteria for sending advertisements. One would have been motivated to do this in order to target users who are often in a certain area.

Claim 4: Haitsuka and Cohen disclose the method according to claim 1. Haitsuka does not explicitly disclose that neighboring transmission areas are set up to overlap each other, and, in the overlapping portion of the transmission areas, advertising information according to the passage count of the client in each of the overlapping transmission areas is transmitted in accordance with predetermined rules.

Art Unit: 3622

However, Cohen discloses that neighboring transmission areas are set up to overlap each other, and, in the overlapping portion of the transmission areas, advertising information according to the passage count of the client in each of the overlapping transmission areas is transmitted in accordance with predetermined rules (col 5, lines 45-52; col 1, lines 34-39; col 1, lines 52-56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cohen's overlapping zones with advertising to Haituka's targeting advertising geographically to a user. One would have been motivated to do this in order to provide a range of advertisements for different areas or overlapping areas.

Claim 6, 7: Haituka and Cohen disclose the method according to claim 1.

Haituka does not explicitly disclose that when the client passes through the same transmission area two or more times within a predetermined period of time, the second passage and later are not counted or that the transmission of the advertising information according to the second passage and later to the client is omitted.

However, Haituka discloses tracking a user geographically and that a variety of rules can be utilized for determining to send advertising (Fig. 3).

Haituka further discloses changing advertisements after certain periods of time (col 2, lines 48-50) and recording what advertisements a user was exposed to, for how long, when, etc (col 2, lines 62-67) and controlling the frequency of which a user sees an advertisement (col 6, lines 17-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haituka can utilize user exposure to advertising or time duration

Art Unit: 3622

of exposure as a parameter of whether to show a user new advertising or not. One would have been motivated to do this in order to better control the amount of exposure a user receives to particular advertisements.

Claim 9: Haitsuka and Cohen disclose the method according to claim 1, and Haitsuka further disclose that the transmission area is divided in transmission time periods, and a different piece of advertising information to be transmitted to the client in the transmission area is registered for each transmission time period (col 2, lines 48-50; col 6, lines 17-27).

Claim 10: Haitsuka and Cohen disclose the method according to claim 9, and Haitsuka further disclose that different pieces of advertising information according to the transmission area and the transmission time periods are transmitted to the client (col 2, lines 50-60; Fig. 3, item 140f).

Claim 11: Haitsuka and Cohen disclose the method according to claim 10, and Haitsuka further disclose that when the client is passing through the transmission area, advertising information according to the passage count in the corresponding the transmission time period is transmitted to the client (Fig. 3).

Claim 14, 15: Haitsuka discloses a method, medium receiving advertising information, medium comprising:

transmitting position information of a client sequentially to a server (col 5, line 59-col 6, line 4; col 6, lines 42-45);
receiving from the server advertising information according to the count of passage through that transmission area at that time, when passing through an advertising information transmission

Art Unit: 3622

area in which the position information belongs (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Claim 16: Haitsuka discloses a method receiving advertising information, comprising:
transmitting position information of a client sequentially to a server (col 5, line 59-col 6, line 4; col 6, lines 42-45);
transmitting a request for transfer to the server (Fig. 3);

Art Unit: 3622

receiving the count of passage through a transmission area for the advertising information at the time of transmission of the transfer request or corresponding incentive information to the passage count (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and
storing the received passage count or incentive information on a portable external storage medium (col 4, lines 13-20).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Claim 17: Haitsuka discloses a method receiving advertising information, comprising:

Art Unit: 3622

receiving a transmission management database which defines transmission criteria for advertising information (Fig. 3, 140c);

retrieving from the database a count of passage through the transmission area through which it is passing based on position information of a client, and storing the count of passage (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5);

transmitting to the server a request for transmission of advertising information and the passage count (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and

receiving from the server advertising information according to the passage count in the transmission area at time of the transmitting (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas and the utilization of advertising (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Art Unit: 3622

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haituka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

4. Claim 5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haituka (6,366,298) in view of Cohen (5,966,696) in further view of Bandera (6,332,127).

Claim 5, 13: Haituka discloses a method transmitting advertising information, comprising:

setting up conditions assigning targeted advertising and advertising information in a

predetermined advertising information transmission area (col 2, lines 50-60);

receiving position information from a number of clients (col 5, line 59-col 6, line 4; col 6, lines 42-45);

determining the state of passage of each of the clients in the transmission area in which the position information from the clients belong (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and

assigning the advertising information to the client or clients that meet the conditions on the basis of the state of passage (col 2, lines 50-60; Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haituka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Art Unit: 3622

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Haitsuka does not explicitly disclose incentives distinct from advertising.

However, Bandera further discloses incentives distinct from advertising (col 3, lines 19-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera's incentives and advertising to Haitsuka's advertising for promotional purposes. One would have been motivated to do this in order to keep better track of different types of advertising and the response to different types of advertising.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka (6,366,298) in view of Cohen (5,966,696) in further view of Gough (6,360,221).

Art Unit: 3622

Claim 8: Haitsuka and Cohen disclose the method according to claim 1.

Haitsuka further discloses fees and user control over content (col 2, lines 35-41; col 4, lines 53-56).

Haitsuka does not explicitly disclose that the transmission of advertising information to the client is omitted as instructed by the client.

However, Gough discloses that the transmission of advertising information to the client is omitted as instructed by the client (col 6, lines 30-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gough's omission of advertisements to Haitsuka's user control of content. One would have been motivated to do this in order to provide better user control over user paid services.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Obradovich (6,148,261) discloses tracking user geographic locations and advertising;
- b. Giraud (5,966,696) discloses tracking user proximity and advertising;
- c. Fano (6,317,718) discloses tracking user geographic locations and advertising;
- d. Verdonk (6,330,454) discloses tracking user geographic locations and advertising.

Art Unit: 3622

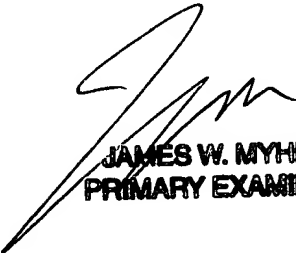
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AO

4/1/04


JAMES W. MYHRE
PRIMARY EXAMINER